



Michael S. Greenfield
McDonnell Boehnen Hulbert & Berghoff
300 South Wacker Drive, 32nd Floor
Suite 3200
Chicago IL 60606

| | | |
|---------------------------------------|---|-------------------|
| In re Application of | : | |
| JEAN RENE CARTIER (deceased) | : | DECISION ON |
| Application No.: 09/937,103 | : | |
| PCT No.: PCT/FR00/00730 | : | PETITION |
| Int. Filing Date: 23 March 2000 | : | |
| Priority Date: 23 March 1999 | : | UNDER 37 CFR 1.42 |
| Attorney Docket no.: 01-1081 | : | |
| For: USE OF TREHALOSE FOR STABILISING | : | |
| A LIQUID VACCINE | : | |

This is a decision on a submission under 37 CFR 1.42, filed in the United States Patent and Trademark Office (USPTO) on 08 February 2002, in response to a 01 November 2001 Notification of Missing Requirements. Applicant requests a one month extension of time, which is granted.

BACKGROUND

On 18 September 2001, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter were, *inter alia*, the requisite basic national fee and a declaration and power of attorney signed by first named inventor Sandrine Lentsch Graf.

In response to the Notification of Missing Requirements mailed on 01 November 2001, and to satisfy the requirement that an oath or declaration of all inventors be furnished, applicant filed a declaration on 08 February 2002 that was signed by an unidentified signatory for deceased inventor Jean Rene Cartier and a copy of what appears to be a notarized French language certificate of inheritance, without English translation. The submission was treated as a request for status under 37 CFR 1.42.

DISCUSSION

Pursuant to 37 CFR § 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor,

administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative.

The declaration submitted on 08 February 2002 was executed by an unidentified signatory on behalf of the deceased inventor. The signatory's identity is not provided nor is his/her relationship to the deceased inventor, that is, the legal representative or sole heir of Jean Rene Cartier. It appears that the declaration states the country of citizenship, residency and mailing address of both the deceased inventor and the signatory, as required for compliance with 37 CFR 1.497(a)(3).

Where a declaration is not clear that it includes the signatures of all the heirs, a statement is required clearly indicating whether or not the estate of the deceased inventor was administered by a legal representative or not. Further, if the estate of the deceased inventor was not represented by a legal representative, all of the heirs should be clearly identified in the declaration. The legal representative of a deceased inventor (or all of the heirs where there was no legal representative) must make the application for patent "on the same terms and conditions applicable to the inventor." 35 U.S.C. 117. The declaration as submitted is defective (see 37 CFR 1.64) since the names of the legal representative(s) of the deceased inventor must be set forth in the declaration (or all of the heirs where there was no legal representative) and they must identify themselves as the legal representative of the deceased inventor.

The declaration is unacceptable because it does not clearly identify the signatory and state signatory's relationship to the deceased inventor (legal representative or sole heir), as required for compliance with 37 CFR 1.497. Furthermore, an explanation of the unidentified French language document with English translation is required. It would appear from the French document that there is more than one heir. Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42 until an acceptable declaration under 37 CFR 1.497(a) and (b), 37 CFR 1.64(b), and 37 CFR 1.42 is submitted.

CONCLUSION

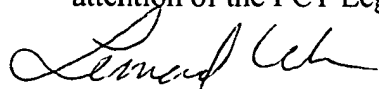
For the above reasons, the request for status under 37 CFR 1.42 is presently DISMISSED WITHOUT PREJUDICE.

If reconsideration of the merits of the request for status under 37 CFR 1.42 is desired, applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 37 CFR 1.42 and 1.497 within TWO (2) MONTHS from the mail date of this Decision. Failure to respond will result in the abandonment of the application.

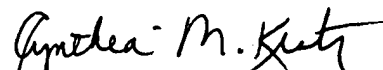
Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Request Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard E. Smith
Legal Examiner
PCT Legal Office



Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK/LES:cmk
Telephone: (703) 306-5467